

### **REMARKS**

The present application has been reviewed in light of the Office Action dated September 21, 2006. Claims 1-18 are currently pending, of which, claims 15-18 have been withdrawn. In light of the remarks that follow, reconsideration of the present application is respectfully requested.

Applicants gratefully acknowledge that the Examiner has indicated that claim 7 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

Claims 1-2, 4-6, and 12-13 were rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 5,439,467 to Benderev et al. (hereinafter "Benderev"). Applicants submit that Benderev does not disclose, teach, or suggest the template recited in independent claims 1 and 12, and therefore, that claims 1-2, 4-6 and 12-13 are allowable.

As previously presented, claims 1 and 12 substantially recite, *inter alia*, at least one **template** including an elongate body defining X, Y, and Z axes adapted for insertion in a patient's knee serving to substantially approximate (1) the configuration of the mechanical device used to repair the meniscal tear and (2) the path it will follow through the surrounding tissue. (Emphasis added). Therefore, the template disclosed in the present application is the element or apparatus facilitating a path to the site of meniscal injury ***separate and distinct*** from the mechanical device subsequently used to repair the injury.

Benderev discloses “a suture passer . . . adapted for releasably retaining a suture”. (Col. 2, lines 32-33). As indicated in the specification, the invention disclosed in Benderev *performs the disclosed function* on the underlying target tissue, as the suture passer is “adapted for grasping and passing internal sutures”. (Col. 4, lines 14-15).

Pursuant to 35 U.S.C. § 102(b), a claim is unpatentable only if each and every element set forth in the claim is found, either expressly or inherently, in a single prior art reference. *See* MPEP 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Office Action argues that Benderev discloses an instrument kit capable of performing a repair procedure having at least one template with an elongated body. In support of this argument, the Office Action refers to Fig. 1 of Benderev. It is respectfully submitted that Benderev fails to disclose a *template*, separate and apart from a repair device, which serves to “approximate a path to a meniscal tear” as substantially recited, *inter alia*, in claims 1 and 12 of the present application. Moreover, it is suggested that Benderev fails to disclose any such approximating device or means. Consequently, Applicant submits that Benderev fails to disclose each and every element of claims 1 and 12 of the present application, as required under 35 U.S.C. § 102(b), since Benderev only discloses the suture passer or repair device itself.

Accordingly, Applicant submits that claims 1 and 12 of the present application are patentably distinguishable from Benderev, and therefore, withdrawal of the rejection of claims 1 and 12 under 35 U.S.C. § 102(b), as being anticipated by Benderev, is respectfully requested.

As claims 2, 4, 6 and 13 depend, directly or indirectly, from claims 1 and 12, Applicant respectfully submits that these claims, too, are in condition for allowance.

Claims 3, 10-11 and 14 were rejected in the Office Action pursuant to 35 U.S.C. § 103(a) over Benderev in view of U.S. Patent No. 6,666,872 to Barreiro et al. (hereinafter "Barreiro").

The Office Action relies on Barreiro for the teaching of the dimensions and configurations of the devices recited in claims 3, 10-11 and 14 of the present application. As discussed above, Benderev fails to disclose the template substantially recited in each of claims 1 and 12 of the present application. Applicant submits that Barreiro fails to remedy the deficiencies in Benderev in that Barreiro fails to disclose a template, separate and apart from a repair device, as substantially called for in claims 1 and 12. Thus, Benderev, taken in any proper combination with Barreiro, fails to suggest all of the limitations and features of claims 1 and 12.

Additionally, as claims 3, 10-11 and 14 depend, directly or indirectly, from claims 1 and 12,

Applicant respectfully submits that the combination of Benderev and Barreiro fails to render claims 3, 10-11 and 14 unpatentable, and therefore the Examiner's rejection of claims 3, 10-11 and 14 under 35 U.S.C. § 103(a), as being obvious over Benderev in view of Barreiro, should be withdrawn.

Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Benderev in view of U.S. Patent 3,842,824 to Neufeld (hereinafter "Neufeld").

The Office Action argues that Neufeld teaches the removably attachable handle recited in claims 8-9 of the present application.

As discussed above, Benderev fails to disclose the template substantially recited in claims 1 and 12 of the present application. Applicant submits that Neufeld fails to remedy the deficiencies in Benderev in that Neufeld fails to disclose a template, separate and apart from a repair device, as substantially recited in claim 1. Thus, Benderev, taken in any proper combination with Neufeld, fails to suggest all of the limitations and features of claims 1.

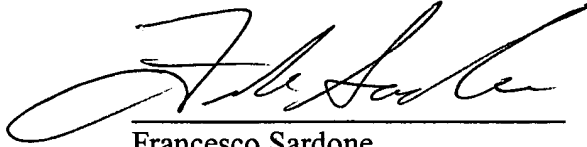
Additionally, as claims 8-9 depend directly from claim 1, Applicant respectfully submits that the combination of Benderev and Neufeld fails to render claims 8-9 obvious, and therefore that claims 8-9 are in condition for allowance. Accordingly, withdrawal of the Examiner's rejection of claim 8-9 under 35 U.S.C. § 103(a), as being unpatentable over Benderev in view of Neufeld, is earnestly solicited.

In view of the foregoing remarks and arguments, and for the reasons set out above, Applicant respectfully submits that claims 1-14 are patentably distinct from the art cited in the Office Action and are in condition for allowance. Favorable action on these claims is requested.

Should the Examiner believe that a telephone or personal interview may facilitate resolution of any remaining matters, the Examiner is respectfully requested to contact Applicant's undersigned attorney at the telephone number indicated below.

Early and favorable action is earnestly requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Francesco Sardone', written over a horizontal line.

Francesco Sardone  
Reg. No. 47,918  
Attorney for Applicants

***CARTER, DELUCA, FARRELL & SCHMIDT, LLP***  
*445 Broad Hollow Road – Suite 225*  
*Melville, New York 11747*  
Telephone: (631) 501-5700  
Facsimile: (631) 501-3526  
FS/nr